

### **REMARKS**

The Office Action of December 8, 2004, has been considered by the Applicants. Claims 1, 5-8, and 21 have been amended. Claims 10-20 have been cancelled. Reconsideration of the Application is requested.

In paragraph 2, the Examiner stated the declaration filed April 22, 2004, was defective because non-initialed and non-dated alterations were made to it with respect to the alterations to the names of the inventors Robert C.U. Yu and Yuhua Tong. A further Declaration, including the full names of the two inventors is attached hereto.

In paragraph 3, the Examiner stated the declaration filed April 22, 2004, listed a different title for the application than recorded by the USPTO. Applicants have amended the title of the instant application to match the title given in the declaration.

In paragraph 4, the Examiner stated the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e) had not been met because the provisional application (Application '866) did not provide an adequate written description of the subject matter recited in the instant claims. Claims whose subject matter is adequately described in Application '866 are entitled to the benefit of the filing date of Application '866. The Formula (II) recited in instant claims 1 and 21 has been clarified to show that the vinyl substituent is attached to the meta position of the phenyl group bonded to the nitrogen atom in the triphenylamine moiety on the right-hand side of the diagram as in Application '866. Contrary to the Examiner's statement, Application '866 does disclose that the compound comprises the central 1,4-divinylphenyl group shown in Formula (II). All diagrams of Formula (II), as seen in the specification of Application '866 on page 4 and in originally filed claims 25 and 26, have lines extending from the vinyl substituents into the central phenyl group and beyond the lines connecting its six carbons. This clearly discloses either a central 1,2-, 1,3-, or 1,4- divinylphenyl group in keeping with standard chemical drawing conventions. For example, see Inagaki (US 6,338,927), which was cited as a reference against the instant application and uses the same drawing conventions. Independent claim 10 has been cancelled; its recital of the phrase "diamines" is therefore moot.

In paragraphs 5, the disclosure was objected to because of several informalities. In item 1, the Examiner noted several spelling errors. The specification has been reviewed and amended to correct these where applicable. With regards to the word

"hydroxylpropylallulose," the word "hydroxylpropylallulose" has been amended to "hydroxylpropylcellulose. In item 2, the Examiner noted the use of trademarks. Trademarks have been capitalized and accompanied by generic terminology in the two paragraphs of the specification which use them. Applicants request withdrawal of the objections.

In paragraph 6, the specification was objected to as failing to provide proper antecedent basis. In item 1, the Examiner alleged the recitation of polymer binders in claims 1 and 21 lacked antecedent basis. Claims 1 and 21 have been amended. In item 2, the Examiner alleged the recitation of "about 25 to about 40 weight percent" in claim 13 lacked antecedent basis. Although claim 13 has been cancelled, the specification recited a range of "between about 20 and about 45 weight percent" on page 8, lines 2-4; the recitation in claim 13 fell between this range and so proper antecedent basis was provided. Item 3 alleged a lack of antecedent basis for claim 20. Claim 20 was cancelled, so this objection is moot. Applicants request withdrawal of the objections.

In paragraph 7, claims 1, 17, 18, and 21 were objected to because of informalities in spelling the names of various chemical compounds. The noted misspellings have been corrected, as have other typographical errors where hyphens and apostrophes were either omitted or incorrectly used. These changes did not affect the scope of claims 1 and 21. In addition, two compounds were added to the group of hole mobility organic transport compounds in the first (bottom) charge transport layer: N,N'-diphenyl-N,N'-bis(halophenyl)-1,1'-biphenyl-4,4'-diamine and N,N'-diphenyl-N,N'-bis(hydroxyphenyl)-1,1'-biphenyl-4,4'-diamine. Support for these additions can be found in the specification in the paragraph beginning on page 19, line 6. Applicants request withdrawal of the objections.

In paragraph 9, claims 1-21 were rejected under 35 U.S.C. § 112, ¶ 2, as failing to distinctly claim the subject matter regarded as the invention. Applicants traverse the rejections.

The Examiner stated claims 1 and 21 were indefinite in the term "hydrozole." Applicants have amended the term "hydrozone" to "hydrazone." The Examiner stated claims 1, 19, and 21 used improper Markush language. Claims 1 and 21 have been amended to use proper Markush language. The Examiner stated claim 5 was indefinite

in the phrase "the first (bottom) charge transport layers." Claim 5 has been amended to recite the "layer." These amendments were made to clarify the meaning of the claims as filed, not for reasons of patentability. Claims 10, 18, and 20 have been cancelled and their rejection is therefore moot. Applicants request withdrawal of the rejections based on failure to distinctly claim the invented subject matter.

In paragraph 10, claims 1-21 were rejected under 35 U.S.C. § 112, ¶ 2, as incomplete. In paragraph 12, claims 1-21 were rejected under 35 U.S.C. § 112, ¶ 1, as based on a disclosure which is not enabling. Applicants traverse both rejections.

The Examiner based both rejections on the omission from independent claims 1 and 21 of an electrically conductive substrate or substrate comprising an electrically conductive layer. The paragraph beginning at page 10, line 31, of the specification clearly discloses that an electrically conductive surface is required, either inherently in the substrate or as the result of a coating on the substrate. The original wording of "a supporting substrate" and "an optional electrically conductive layer" was intended to encompass both of those situations, but inadvertently encompassed the third situation of a non-conductive supporting substrate. Claims 1 and 21 have been amended to ensure the intended limitation is understood. These amendments were not made for reasons of patentability, but rather to clarify the meaning of the originally-filed claims. Applicants request withdrawal of the rejections based on incompleteness and non-enabling disclosure.

In paragraph 16, claims 10, 12-18, and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by US 5,401,615 (Pai '615). As claims 10-20 have been cancelled, this rejection is moot.

In paragraph 17, claims 1-6, 8, 10, 19, and 21 were rejected under 35 U.S.C. § 103(a) as obvious over Pai '615 combined with US 6,338,927 (Inagaki). Applicants traverse the rejections.

Pai '615 and Inagaki together do not disclose all limitations of the instant application. Independent claims 1 and 21 have been amended to recite that at least one of R1-R6 be a halogen. Inagaki does not disclose a stilbene derivative with a halogen substituent; see col. 2, lines 51-61. Because the claimed stilbene compound of Formula (II) is not disclosed, the claims are not obvious. Compounds I-20 and I-21, which were cited by the Examiner, do not fall within the limitation of Formula (II), which

has been amended to show a vinyl group which is meta-substituted. I-20 and I-21 are ortho- and para-substituted. In addition, Inagaki does not teach a multi-layered member as that phrase is used in the instant application. Inagaki defines a multi-layered member as a member comprising a charge generating layer and a charge transferring layer; see col. 1, lines 22-30. He does not specifically disclose a member comprising two charge transferring layers as the instant claims require. Applicants request withdrawal of the rejections for obviousness over Pai '615 and Inagaki.

In paragraph 18, claim 7 was rejected under 35 U.S.C. § 103(a) as obvious over Pai '615 combined with Inagaki and US 4,265,990 (Stolka). Applicants traverse the rejections.

Claim 7 depends upon claim 1. As explained above, claim 1 is not obvious over Pai '615 and Inagaki. Stolka does not remedy the deficiency. Claims which depend upon a non-obvious claim are themselves non-obvious. See MPEP § 2143.03; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants request withdrawal of the rejection for obviousness over Pai '615, Inagaki, and Stolka.

In paragraph 19, claims 10, 11, 13-15, 17 and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by US 2002/0106570 (Kami). As claims 10-20 have been cancelled, this rejection is moot.

In paragraph 20, claims 1-4, 8-10, 19, and 21 were rejected under 35 U.S.C. § 103(a) as obvious over Pai '615 combined with Inagaki and Kami. Applicants traverse the rejections.

As explained above, claim 1 is not obvious over Pai '615 and Inagaki. Kami, which does not recite the particular stilbene compound of Formula (II), does not remedy the deficiency. With regard to claim 8, the Examiner is incorrect in stating that the "Bisphenol A Z-type polycarbonate resin" in the charge transport layers of Kami meets the limitation of claim 8. Pai '615 clearly teaches that A-type and Z-type polycarbonates are different; there is no such thing as a "Bisphenol A Z-type polycarbonate resin." Kami uses only Z-type polycarbonates, which does not meet the limitation of claim 8. Applicants request withdrawal of the rejection for obviousness over Pai '615, Inagaki, and Kami.

In paragraph 21, claims 10, 11, 13-18 and 20 were rejected under 35 U.S.C. § 102(e) as anticipated by US 2004/0126685 (Horgan). As claims 10-20 have been

cancelled, this rejection is moot. In addition, Horgan and the instant application were, at the time the invention of the instant application was made, subject to an obligation of assignment to the same person, Xerox Corporation. See the declaration of April 22, 2004, which also lists Horgan as a co-inventor. Horgan would thus be excluded as prior art under 35 U.S.C. § 103(c) as well. See MPEP § 706.02(I)(2).

In paragraph 23, claims 10, 11, 13-18 and 20 were provisionally rejected under the doctrine of obviousness-type double patenting as unpatentable over claims 1-24 of US 6,780,554 (Tong). As claims 10-20 have been cancelled, this rejection is moot.

In paragraph 24, claims 10, 11, 13-18 and 20 were provisionally rejected under the doctrine of obviousness-type double patenting as unpatentable over claims 21-31 of copending Application 10/737,545. As claims 10-20 have been cancelled, this rejection is moot.


In paragraph 25, claims 10-18 and 20 were provisionally rejected under the doctrine of obviousness-type double patenting as unpatentable over claims 1-42 of copending Application 10/736,864. As claims 10-20 have been cancelled, this rejection is moot.

### **CONCLUSION**

For the above reasons, all pending claims (claims 1-9, 21) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,  
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